

REMARKS

Applicant has carefully reviewed the Office Action mailed May 20, 2004, and offers the following remarks in response thereto.

Claims 1-3, 5, 7-11, and 13-16 were rejected under 35 U.S.C. § 101 as not reciting a limitation in the technological arts. Applicant respectfully traverses. A toll call, such as that recited in the claims, cannot occur without a telecommunications device of some sort. While the Patent Office opines that the recited limitations are abstract ideas which can be performed mentally without interaction of a physical structure, Applicant cannot imagine a situation where "initiating a toll call to a call recipient" can occur without the intervention of a physical device. The intervention of the physical device places the claimed subject matter squarely within the confines of the technological arts. If the Patent Office disagrees, Applicant requests that the Patent Office provide evidence as to how a toll call can be initiated without the intervention of a physical structure. Applicant further notes that the Federal Circuit has opined that a process that may be performed by a person, but that is also capable of being performed by a machine, is not fatal to patentability. *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F.2d 1490 (Fed. Cir. 1986).

Claims 18-20, 22, 24-28, 30, 32, 33, and 55 were rejected under 35 U.S.C. § 112, second paragraph as being incomplete for omitting essential elements. Specifically, the Patent Office opines that there is no structural element which would provide the functionality of the system. Applicant respectfully traverses.

Applicant initially traverses the rejection because the Patent Office is misapplying MPEP § 2172.01. Specifically, MPEP § 2172.01 indicates that where essential elements are omitted, § 112, first paragraph may be used to reject the claims. Such a rejection is premised on the subject matter being identified as essential (either in the specification or in other statements of record). The Patent Office has not identified a particular structural element that Applicant has indicated as being essential. MPEP § 2172.01 also contemplates a rejection under 35 U.S.C. § 112, second paragraph where there is a failure to interrelate essential elements. Again, the Patent Office has not identified any element that has been identified as essential. Absent the identification of an essential element, the omission of any element is not a proper basis for a § 112, second paragraph rejection.

Applicant further traverses the rejection because this rejection is demonstrably false.

Claim 18 recites a control system. Figures 4 and 5 illustrate control systems, which are generally understood by those skilled in the art to include structural components, complying with the Patent Office's stated basis for rejecting the claim. Claims 19, 20, 22, 24-28, 30, 32, 33, and 55 depend from claim 18 and thus have the same structural component. Applicant requests withdrawal of the § 112 rejection at this time.

Before addressing the rejections based on Kalmanek, Jr. et al., Applicant provides a brief summary of the invention so that the remarks relating to Kalmanek, Jr. et al. are considered in the proper context. The present invention is designed to share the cost of a toll call between the party normally responsible for the toll call and the party normally not responsible for the toll call. To help effectuate this toll sharing, the present invention provides a request to share the toll and the opportunity for the party normally not responsible for the toll to accept a portion of the toll. After receipt of the acceptance, the toll is apportioned according to the toll sharing parameters. In one embodiment, the request and acceptance may be done before a particular call is initiated. That is, for example, a family may decide that a child's calls home from college will be split 60-40 with the child paying 60% of the cost of the call and the remaining 40% being billed to the family phone. Once this arrangement is in place, all calls from the child's phone will be billed accordingly. However, the initial set up for this arrangement remains the same, with the calling party making a request for toll sharing, providing the information relating to the toll sharing to the called party, and receiving the decision from the called party.

Claims 1-3, 5, 7-11, 13, 15, 18-20, 22, 24-28, 30, 32, 33, 35-37, 39, 41-45, 47, 49, and 54-56 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kalmanek, Jr. et al. (hereinafter "Kalmanek"). Applicant respectfully traverses. For the Patent Office to establish anticipation, the Patent Office must show where in the reference each and every claim element is located. Further, the elements of the reference must be arranged as claimed. MPEP § 2131. These requirements are strict and must be complied with thoroughly in an anticipation analysis.

The Patent Office analyzes claims 1, 18, and 35 together, stating that "receiving a request for toll sharing, the request originating in a telephony device; receiving proposed toll sharing parameters, initiating a toll call, informing the call recipient, [and] receiving a decision" are shown at Kalmanek, col. 11, lines 41-57. Applicant traverses this broad assertion. As explained above, and as recited in the claims, the present invention has a request for toll sharing, informing

the call recipient of the proposed toll sharing parameters, and receiving a decision from the call recipient. While Kalmanek contemplates toll sharing, Kalmanek's toll sharing is split based on the existence of a call forwarding condition. That is, the call initiator is billed for the cost of the call to the original destination, and the call recipient is billed for the cost of the forwarded portion of the call (see abstract, lines 8-12; col. 2, lines 7-10). Kalmanek, col. 11, approximately lines 41-57 states as follows:

So, where a call involves a calling party and a called party using telephones, the end-to-end association for the call can be between the two telephony interface units; thus, end-to-end messages would include messages originating at one telephone interface unit and terminating at the other telephony interface unit.

The end-to-end messages can include, for example, a ring message from the originating TIU 170 to the terminating TIU 171, a ring back message from the terminating TIU 171 to the originating TIU 170, and a connect message from the terminating TIU 171 to the originating TIU 170. The ring message can signal the terminating telephone 191 to ring thereby indicating an incoming call. The ring back message can signal the originating TIU 170 that the terminating telephone 190 is ringing. The connect message can signal to the originating TIU 170 that the called party has indicated acceptance for the call by, for example, going off-hook.

The first part of the passage discusses generic end-to-end messages, but makes no reference to a request to share tolls, informing the call recipient of the proposed toll sharing parameters or receiving a decision from the call recipient. The second part of the passage describes in more detail the nature of the messages, but states that these are a ring message, a ring back message, or a connect message. The ring message is indicative of an incoming call, not a request for toll sharing, informing the called party of the toll sharing parameters, or receiving a decision from the call recipient. The ring back message is indicative of the phone ringing, but is not the request to share tolls, informing the call recipient of the proposed toll sharing parameters or receiving a decision from the call recipient. The connect message indicates acceptance of the call, but this is not the decision from the call recipient that the toll sharing parameters are accepted, because the call recipient has never been informed of the toll sharing parameters. Likewise, the connect message is not a request for toll sharing or informing the call recipient of the toll sharing parameters. The cited passage does not teach or suggest the claim elements for which it is cited. Since the reference does not teach the claim elements, the

reference cannot anticipate the claims. If the Patent Office has an alternate reading of the reference, Applicant requests that the Patent Office articulate such with greater particularity, explaining how the cited passage teaches the claim elements.

Claims 2, 3, 5, 7-11, 13, 15, 19, 20, 22, 24-28, 30, 32, 33, 36, 37, 39, 41-45, 47, 49, and 54-56 depend from claims 1, 18, and 35 and are not anticipated at least for the same reasons.

With respect to the Patent Office's citation of *In re Danly*, Applicant notes that the present case is distinguishable. In *Danly*, the CCPA affirmed the rejection of claims 1 and 2 because the claim recited "the construction being such that alternating electric current may be passed through the tie rod to heat the same." The CCPA, in its analysis, indicated that given that the structure was old, the use of "may be" did not form a positive limitation. In the words of the CCPA, the language did not "constitute a structural limitation, since an alternating current may be passed through any tie rod which is insulated from the frame . . ." *In re Danly*, 263 F.3d 844, 847 (CCPA 1959) (emphasis added). This case does not stand for the proposition that an apparatus must be defined by structure and not function; rather, this case reflects the position that hypothetical functions are not limitations. The CCPA actually confirmed that functions can be limitations in the analysis of claims 3-7 (noting that means "for insulating" and four tie rods "for holding" were acceptable functional limitations).

Likewise, the Patent Office's reliance on *Ex parte Masham* is misplaced. The Patent Office opines that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate from the prior art if all the structural limitations are taught. However, the claim language for claims 18-33 and 55 does not recite an intended purpose. The claim language recites a control system (i.e., a structural component) adapted to perform specific functions. Such functional limitations are to be given patentable weight. *Pac-Tec v. Amerace Corp.*, 903 F.2d 796, 801 (Fed. Cir. 1990).

Claims 16 and 50 were rejected under 35 U.S.C. § 103 as being unpatentable over Kalmanek. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every claim element is located in the reference. MPEP § 2143.03.

As explained above with respect to claim 1 (and similar claim 35), Kalmanek does not teach or suggest the reception of a request for toll sharing, informing the call recipient of the proposed toll sharing parameters, and receiving a decision from the call recipient as to whether

the toll sharing parameters are accepted. Absent such a teaching or suggestion, the reference does not establish *prima facie* obviousness, and the claims are allowable.

Applicant requests reconsideration of the rejection in light of the remarks presented herein. The Patent Office has created rejections that are not supported on the record before the Patent Office, and Applicant requests withdrawal thereof. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.C.

By:

Benjamin S. Withrow
Registration No. 40,876
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

Date: August 19, 2004
Attorney Docket: 7000-051

CERTIFICATE OF TRANSMISSION
I HEREBY CERTIFY THAT THIS DOCUMENT IS BEING
TRANSMITTED VIA FACSIMILE ON THE DATE INDICATED BELOW
TO:

Examiner: Borissov, Igor Art Unit: 3629 Fax: 703-872-9306

Kelly Farisow

Name of Sender

Kelly

Signature

8/19/04

Date of Transmission